



17 DEC 2008

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In re Application of  
DESINGER et al.  
Application No.: 10/564,322  
Filed: June 26, 2006  
Attorney Docket No.: 3444  
For: SURGICAL PROBE

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed October 23, 2008 to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional and international applications set forth in the amendment filed concurrently with the instant petition.

The petition is DISMISSED.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional and international applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) and (3).

An amendment adding a reference to the prior-filed nonprovisional and international applications to the first sentence of the specification following the title has been included in a concurrently filed amendment. However, the amendment fails to state the relationship of USSN 10/806,867 filed March 23, 2004 and U.S. Pat No. 6,723,094 issued April 20, 2004 to the instant application. (See 37 CFR 1.78(a)(2)(i)) The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. Furthermore, the benefit claim is not proper since it identifies the Patent number (U.S. Pat No. 6,723,094), instead of the U.S. serial number (USSN 09/868,303). An example of a proper benefit claim is: "This application is a continuation of application No. ---, filed---." A benefit claim that merely states: "This application claims the benefit of application No. ---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. See MPEP Section 201.11, Reference to Prior Application.

As to item (3), a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional is required. Here, applicant states "[t]he entire delay between the date the claim was due under 37 CFR 1.78(d)(4) and today was unintentional." Applicant's statement refers to 37 CFR 1.78(d)(4), not 37 CFR 1.78(a)(2)(iii). Therefore, a new statement is required.

Therefore, before the petition under 37 CFR § 1.78(a)(3) and (a)(6) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required. Additionally, a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional is required.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3298.

A handwritten signature in black ink, appearing to read 'Boris Milef', is positioned above the printed name.

Boris Milef  
Legal Examiner  
PCT Legal Administration